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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,970	11/09/2001	Philip J. Passantino	301098	3787
28264 7590 08/09/2007 BOND, SCHOENECK & KING, PLLC ONE LINCOLN CENTER SYRACUSE, NY 13202-1355			EXAMINER GLASS, RUSSELL S	
			ART UNIT 3626	PAPER NUMBER
			MAIL DATE 08/09/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/035,970

Applicant(s)

PASSANTINO, PHILIP J.

Examiner

Russell S. Glass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/29/2007 has been entered.

### ***Claim Objections***

2. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant has acted as his own lexicographer and re-defined client to include all limitations of claim 14. Therefore claim 14 is equal in scope to claim 13. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldenberg, (U.S. Pub. 2002/0065682), in view of Joao, (U.S. 2002/0032099).**

4. As per claims 13 and 14, Goldenberg discloses a computer-based method of managing a network of physicians comprising the steps of:

providing secure access to the network to a client through a computer terminal, (Goldenberg, Fig. 3; ¶¶ 9, 42, 47) (passwords providing secure and limited access);

allowing said client to request a referral for a specific medical need, (Goldenberg, ¶¶ 15, 50-53, 67);

retrieving from a referral database information about at least one physician capable of handling the referral, (Goldenberg, ¶¶ 15, 50-53, 67);

displaying said information for said client, (Goldenberg, ¶¶ 15, 50-53, 67);

allowing said client to select said at least one physician, (Goldenberg, ¶¶ 15, 50-53, 67);

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requesting a response from said client to at least one inquiry established by said at least one physician, (Goldenberg, ¶ 50, 67)(disclosing questions from physician to patient regarding past diagnosis and treatment, said questions being a form of inquiry);

securely transmitting patient information from a client database to said at least one physician after receiving a response to said inquiry, (Goldenberg, ¶ 40) (disclosing an information retrieval system that encodes data for security purposes);

generating a request to have said at least one physician provide medical services, (Goldenberg, ¶¶ 15, 50-53, 67); and

tracking said request to ensure that the medical services are provided, (Goldenberg, ¶ 50)(disclosing a system programmed to select another physician to perform the medical services if the first physician cannot perform the requested medical service, thus ensuring that the requested medical services are provided).

Goldenberg fails to disclose a method wherein said client is selected from the group consisting of an HMO, a PPO, a POS plans, a TPA, a self-insured employer, a health insurance carrier, and a payor. However, such a method step is well-known in the art as evidenced by Joao, (Joao, ¶ 251)(disclosing a user as a payor).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Goldenberg and Joao. The motivation would have been to process healthcare claims, (Joao, ¶ 43).

5. As per claim 15, Goldenberg discloses a method further comprising the step of confirming that said client is authorized to access said network of physicians,

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(Goldenberg, ¶¶ 42, 47) (the password and user I.D. are used to confirm access authorization).

The motivation to combine Goldenberg and Joao is as provided in the rejection of claim 13 and incorporated herein by reference.

6. As per claim 16, Goldenberg discloses a method wherein said physician database comprises a plurality of physician profiles, (Goldenberg, ¶ 50) (selected professional resumes are displayed, said resume are considered to be a profile).

The motivation to combine Goldenberg and Joao is as provided in the rejection of claim 13 and incorporated herein by reference.

7. As per claim 17, Goldenberg discloses a method wherein each of said plurality of physician profiles includes said at least one inquiry, (Goldenberg, ¶ 50, 67)(disclosing questions from physician to patient regarding past diagnosis and treatment, said questions being a form of inquiry).

The motivation to combine Goldenberg and Joao is as provided in the rejection of claim 13 and incorporated herein by reference.

8. As per claim 18, Goldenberg discloses a method further comprising the step of interfacing with a client computer system to upload demographic information, (Goldenberg, ¶ 50)(disclosing transmitting and gathering a patient history screen to

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adequately answer an inquiry, said patient history screen is considered to include demographic information).

The motivation to combine Goldenberg and Joao is as provided in the rejection of claim 13 and incorporated herein by reference.

**9. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldenberg, (U.S. Pub. 2002/0065682), in view of Joao, (U.S. 2002/0032099), and further in view of Stephanou, (U.S. 6,505,166).**

10. As per claim 19, Goldenberg fails to disclose a method further comprising the step of recruiting at least one physician to participate in said network of physicians. However, such a method step is well-known in the art as evidenced by Stephanou, (Stephanou, col. 7, lines 51-57).

It would be obvious to one of ordinary skill in the art to combine Goldenberg and Joao with Stephanou. The motivation would be to create a virtual help desk to provide experts in many areas of expertise immediately and competently in response to queries for help from customers. However, such a method step is well-known in the art as evidenced by Stephanou, (Stephanou, col. 2, lines 30-33).

11. As per claim 20, Goldenberg fails to disclose a method further comprising the step of further comprising the step of providing independent review of the referral prior to the step of generating said request. However, such a method step is well-known in

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the art as evidenced by Stephanou, (Stephanou, col. 3, lines 26-43)(disclosing a reviewing a database of qualified experts based on availability prior to generating a request for that expert).

The motivation to combine Goldenberg and Joao is as provided in the rejection of claim 13 and incorporated herein by reference.

The motivation to add Stephanou is as provided in the rejection of claim 19 and incorporated herein by reference.

12. As per claim 21, Goldenberg fails to disclose a method further comprising the step of further comprising the step of tracking the success rates and costs of referrals among the network of physicians. However, such a method step is well-known in the art as evidenced by Stephanou, (Sephanou, col. 4, lines 21-51. col. 6, lines 18-23)(disclosing tracking of performance and fees via a survey, said performance and fees are considered to be equivalent to success rates and costs of referrals).

The motivation to combine Goldenberg and Joao is as provided in the rejection of claim 13 and incorporated herein by reference.

The motivation to combine Goldenberg and Stephanou is as provided in the rejection of claim 19 and incorporated herein by reference.

### ***Response to Arguments***

1. As per Applicant's argument that the previous final rejection is premature is not persuasive. MPEP 706.07(a) states that "under present practice, second or any



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subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims...". In this case the claims submitted on 4/12/2006 are new claims that are amended and different in scope than those originally submitted by preliminary amendment on 5/2/2002. New claims are an amendment even if new matter is not added. Additionally, Applicant voluntarily abandoned the previous application by filing the current RCE. MPEP 706.07(c) states that:

any question as to prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c).

2. Applicant's other arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

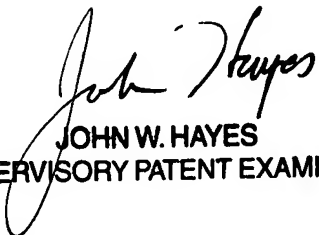
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RSG  
8/1/2007

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JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER